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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,795	08/04/2003	Chester A. Bacon JR.	56345US013	7241

32692 7590 02/07/2005

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ST. PAUL, MN 55133-3427

EXAMINER
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BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/633,795

Applicant(s)

BACON, CHESTER A.

Examiner

Melanie D. Bissett

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 12, 17, 28, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Each claim recites "comprises at least one ultraviolet absorber, light stabilizer, and mixtures thereof." It is unclear whether the applicant intends to claim "comprises at least one compound selected from an ultraviolet absorber, light stabilizer, and mixtures thereof" or whether the applicant intends to claim the entire mixture as it is written.

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1711

5. Claims 1-18 and 20-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,660,390 in view of Hedblom et al.

6. Patented claims 1 and 20 contain all of the limitations of present claim 1 with the exception of the color shift limitation. Patented claims 12 and 21 contain all of the limitations of present claim 20 with the exception of the color shift limitation. In light of the specification of the patent, it is clear that weathering properties are a concern of the inventors (see table VIII). Hedblom teaches that UV stabilizers and pigments may be added to both the barrier layer and the bonding layer of a retroreflective article to prevent discoloration of the article (col. 5 line 31-col. 6 line 60). It is the examiner's position that it would have been obvious to include any amounts of pigments and UV stabilizers necessary to optimize the weathering properties of the articles. It is the examiner's position that the claimed color shift would be achieved by such actions, since the patent claims the same materials presently claimed.

7. The patented dependent claims teach the limitations of the present dependent claims 2-11, 15-16, 18, 21-23, 26-27, and 30. Regarding the limitation that the layer is transparent, it is the examiner's position that the claims describe the same types of materials for the layer and would therefore have the same transparency properties. Regarding the thickness values, Hedblom teaches that barrier layers of 50-150 microns are used to prevent discoloration. Thus, it would have been obvious to use thicknesses within the claimed values to obtain articles of improved color prevention.

8. Claims 19 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,660,390 in view of Hedblom et al. and further in view of Selwyn.

9. The patent and Hedblom apply as above, teaching colorant layers and pigments but failing to mention fluorescent pigments. Selwyn teaches that fluorescent pigments improve daytime visibility when used with retroreflective pigments. Therefore, it would have been obvious to use fluorescent pigments in the inventions of the patent and Hedblom to improve daytime visibility.

10. Claims 1-18 and 20-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,723,433 in view of Hedblom et al.

11. Patented claim 14 contains all of the limitations of present claim 1 with the exception of the color shift limitation and the ink layer limitation. Patented claim 14 contains all of the limitations of present claim 20 with the exception of the color shift limitation. In light of the specification of the patent, it is clear that weathering properties are a concern of the inventors (see table VIII). Hedblom teaches that UV stabilizers and pigments may be added to both the barrier layer and the bonding layer of a retroreflective article to prevent discoloration of the article (col. 5 line 31-col. 6 line 60). It is the examiner's position that it would have been obvious to include any amounts of pigments and UV stabilizers necessary to optimize the weathering properties of the

Art Unit: 1711

articles. It is the examiner's position that the claimed color shift would be achieved by such actions, since the patent claims the same materials presently claimed.

12. The patented dependent claims teach the limitations of the present dependent claims 4-11, 14-16, 18, 23, 25-27, and 30. Regarding the limitations that the layer is transparent, flexible, and stain resistant, it is the examiner's position that the claims describe the same types of materials for the layer and would therefore have the same properties.

13. Claims 19 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,723,433 in view of Hedblom et al. and further in view of Selwyn.

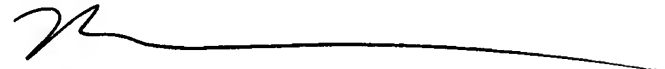
14. The patent and Hedblom apply as above, teaching colorant layers and pigments but failing to mention fluorescent pigments. Selwyn teaches that fluorescent pigments improve daytime visibility when used with retroreflective pigments. Therefore, it would have been obvious to use fluorescent pigments in the inventions of the patent and Hedblom to improve daytime visibility.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melanie D. Bissett  
Patent Examiner  
Art Unit 1711

mdb